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AMIN, TUROCY & CALVIN, LLP			EXAMINER	
24TH FLOOR, NATIONAL CITY CENTER			PEARSON, DAVID J	
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CLEVELAND, OH 44114			ART UNIT	PAPER NUMBER
			2137	
			NOTIFICATION DATE	DELIVERY MODE
			06/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/729,798

Applicant(s)

HIRST, ROY

Examiner

DAVID J. PEARSON

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. Claims 1, 4-7, 9-11, 14-17, 20-21 and 23 have been amended. Claims 18-19 have been canceled. Claims 24-25 are newly added. Claims 1-17 and 20-25 have been examined.

Response to Arguments

2. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-17 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabinovitch (U.S. Patent Application Publication 2006/0101521), and further in view of Matsuyama et al. (U.S. Patent 6,574,611, hereafter Matsuyama) and Friedman et al. (U.S. Patent 7,039,806, hereafter Friedman).

For claims 1, 11 and 16, Rabinovitch teach a method and computer readable storage medium of storing digitally encoded material, the method comprising:

Associating one or more built-in functions (note paragraph [0047]) with digitally encoded material such that the built-in functions are coupled to the digitally encoded material (note paragraph [0040]); and

Rendering or transforming the digitally-encoded material based on the built-in functions (note paragraph [0047]), **wherein the digitally-encoded material can be transformed and rendered only by the built-in functions** (note paragraph [0051], last sentence).

Rabinovitch differs from the claimed invention in that he fails to teach:

Associating a unique identifier with digitally encoded material; and

The unique identifier is coupled to the digitally encoded material.

Matsuyama teaches:

Associating a unique identifier with digitally encoded material (note column 15, lines 9-14); and

The unique identifier is coupled to the digitally encoded material (note FIG. 17, 12A and 12B).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the built-in functions of Rabinovitch and the content ID of

Matsuyama. It would have been obvious because combining the prior art elements according to known methods would have yielded the predictable results a content package with both an ID and built-in functions.

The combination of Rabinovitch and Matsuyama differs from the claimed invention in that they fail to teach:

The built-in functions include at least an encrypt and a decrypt function.

Friedman teaches:

The built-in functions include at least an encrypt and decrypt function (note column 3, lines 41-43).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the combination of Rabinovitch and Matsuyama with the built-in encryption function of Friedman. It would have been obvious because combining the prior art elements according to known methods would have yielded the predictable results a content package with a built-in encryption function.

For claims 2-3 and 17, the combination of Rabinovitch, Matsuyama and Friedman teaches claims 1 and 16 further comprising:

Associating a history of the digitally encoded material with the digitally encoded material (note column 23, lines 52-56 of Matsuyama), **wherein the history being located in a database** (note column 23, lines 11-21 of Matsuyama).

For claim 4, the combination of Rabinovitch, Matsuyama and Friedman teaches claim 1, wherein the built-in function includes one or more of Copy, Paste **or** Print (note paragraph [0047] of Rabinovitch).

For claims 5, 12 and 20, the combination of Rabinovitch, Matsuyama and Friedman teaches claims 1, 11 and 16 wherein the associating the built-in functions **comprising the encrypt function and a decrypt function** with the digitally encoded material enables the digitally encoded material to be stored in RAM in an encrypted form (note column 5, lines 55-58 of Friedman).

For claims 6 and 21, the combination of Rabinovitch, Matsuyama and Friedman teaches a method and computer readable medium for tracking digitally encoded material, the method comprising:

Appending a unique identifier to the digitally encoded material (note column 15, lines 9-14 of Matsuyama);

encrypting a combination including the digitally encoded material and the unique identifier (note column 3, lines 47-49 of Friedman); and

appending built-in function source code and the encrypted combination to form an executable entity (note paragraph [0049] of Rabinovitch and column 4, lines 57-65 of Friedman) capable of being executed independent of a particular operating system (note paragraph [0042] of Rabinovitch), **wherein the digitally-encoded material can be transformed and rendered only by the built-in functions** (note paragraph [0051], last sentence of Rabinovitch) **that comprise at least an encrypt function and a decrypt function** (note column 3, lines 41-43 of Friedman).

For claim 7, the combination of Rabinovitch, Matsuyama and Friedman teaches claim 6 wherein the built-in functions include one or more of Copy, Paste **or** Print (note paragraph [0047] of Rabinovitch).

For claims 8 and 13, the combination of Rabinovitch, Matsuyama and Friedman teaches claims 6 and 11 wherein the built-in functions include rendering functions and transform functions (note paragraph [0047] of Rabinovitch).

For claims 9 and 14, the combination of Rabinovitch, Matsuyama and Friedman teaches claims 8 and 13 wherein the rendering functions include one or more of a close, find shape, full screen, go to guide, help, open (note paragraph [0047] of Rabinovitch), order pan, properties, reveal, rotate/flip, search, select, size, and position, spell check **or** zoom.

For claims 10 and 15, the combination of Rabinovitch, Matsuyama and Friedman teaches claims 8 and 13 wherein the transform function include one or more of copy (note paragraph [0047] of Rabinovitch), DRM agent, export, insert, log, new, paste, print, replace, **or** save as.

For claim 22, the combination of Rabinovitch, Matsuyama and Friedman teaches claim 21 wherein the acts further comprise:

tracking the digitally encoded material by maintaining an auditable document history log (note column 23, lines 52-56 of Matsuyama).

For claim 23, the combination of Rabinovitch, Matsuyama and Friedman teaches claim 22 wherein the auditable document history log is maintained in one of a file associated with the digitally-encoded material and a database independent of the digitally-encoded material (note column 23, lines 11-21 of Matsuyama).

5. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Rabinovitch, Matsuyama and Friedman as applied to claim 10 above, and further in view of Nelson (U.S. Patent 6,691,229).

For claim 24, the combination of Rabinovitch, Matsuyama and Friedman differs from the claimed invention in that they fail to teach:

Including the copy function in the transform functions wherein upon executing the copy function a second unique identifier is generated and appended to a generated

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copy of the digitally encoded material such that the copy comprises the unique identifier and the second unique identifier.

Nelson teaches:

Including the copy function in the transform functions wherein upon executing the copy function a second unique identifier is generated and appended to a generated copy of the digitally encoded material such that the copy comprises the unique identifier and the second unique identifier (note column 7, line 57 through column 8, line 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the combination of Rabinovitch, Matsuyama and Friedman with the enforcement data of Nelson. One of ordinary skill in the art at the time of the invention would have been motivated to combine Rabinovitch, Matsuyama, Friedman and Nelson because it would allow unauthorized copies of content to be traced to the person who accepted the original (note column 4, lines 38-42 of Nelson).

For claim 25, the combination of Rabinovitch, Matsuyama, Friedman and Nelson teaches claim 24, wherein executing the copy function updates document history of the digitally encoded material and the generated copy (note column 23, lines 52-56 of Matsuyama) and informs at least an author of the digitally encoded material of the generated copy (note column 9, lines 31-39; 57-61 of Matsuyama).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DAVID J. PEARSON** whose telephone number is (571)272-0711. The examiner can normally be reached on Monday - Friday, 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DJP

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2137